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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/917,956	07/31/2001	Toshiki Kindo	041-1894D	3203
7590	08/16/2004		EXAMINER	
CLARK & BRODY 1750 K STREET SUITE 600 WASHINGTON, DC 20006			BELL, MELTIN	
			ART UNIT	PAPER NUMBER
			2121	

DATE MAILED: 08/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/917,956

Applicant(s)

KINDO, TOSHIKI

Examiner

Meltin Bell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 33-50 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 33-50 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 29 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☒ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/29/04.  
4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: 8/4/04.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This action is responsive to application **09/917,956** filed 07/31/2001 as well as the Information Disclosure Statement (IDS), Drawing Corrections, Remarks, Claims and Specification Amendments all filed 4/29/04. Claims 33-50 filed by the applicant have been entered and examined. An action on the merits of claims 33-50 appears below.

#### ***Priority***

Applicant is advised of possible benefits under 35 U.S.C. 119(a)-(d), wherein an application for patent filed in the United States may be entitled to the benefit of the filing date of a prior application filed in a foreign country. Acknowledgment is made of applicant's claim for foreign priority based on applications filed in Japan #s 7-226172 on **09/04/95** and 8-031547 on 02/20/96.

Applicant's claims for domestic priority against application numbers 08/707,565 filed 9/4/96 now USPN 6,076,082 issued June 13, 2000 and 09/506,600 filed 2/18/2000 now USPN 6,327,583 issued 12/04/2001 under 35 U.S.C. 120 are also acknowledged.

#### ***Claim Rejections - 35 USC § 103***

Applicant's 35 USC 102 arguments with respect to claim 33 have been considered but are moot in view of this new ground(s) of rejection. The following

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is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Morita* USPN 5,297,042 "Keyword associative document retrieval system" (March 22, 1994) in view of *Duke-Moran et al* USPN 5,819,259 "Searching media and text information and categorizing the same employing expert system apparatus and methods" (Filed December 17, 1992).

**Regarding claim 33:**

*Morita* teaches,

- inputting a user's necessity or a user's non-necessity for each of pieces of information data (Abstract, "A document retrieval ... as a retrieval result"; column 2, lines 39-43, "The input analysis ... by a user"; column 3, lines 7-9, "The user determines ... to the user")
- calculating a prediction value predicting a user's necessity degree for each of a plurality of keywords attached to the pieces of information data according to the user's necessities and the user's non-necessities for the pieces of information data and the keywords attached to the pieces of information data (column 2, lines 43-65, "The input analysis ... the output controller 3"; column 3, lines 1-16, "The relevance values ... with predetermined equations"; column 4, lines 10-36, "The input portion 8 ... the retrieval result")

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- assigning expected and relevance values to each document (column 2, lines 58-65, "The associative retrieval ... the output controller 3"; column 5, lines 20-22, "it is possible ... to the document")

- assigning weight data to each keyword (column 2, lines 43-46, "The input analysis ... associative retrieval unit 2"; column 4, lines 10-14, "The weight data ... the input layer 5"; column 5, lines 6-7, "Thus, in th ... of each keyword")

However, *Morita* doesn't explicitly teach assigning each calculated prediction value to the corresponding keyword while *Duke-Moran et al* teaches,

- assigning each calculated prediction value to the corresponding keyword (column 15, lines 25-35, "The tags essentially indicate ... the word is TRUE")

Motivation – The portions of the claimed method would have been a highly desirable feature in this art for

- Correlating electronically obtained media/text information (*Duke-Moran et al*, column 2, line 38, "correlating electronically obtained media/text information")

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify *Morita* as taught by *Duke-Moran et al* for the purpose of correlating electronically obtained media/text information.

**Regarding claim 34-41:**

Claims 34-41 are rejected for being dependent on the above rejected independent claim 33 and for reasons given in the prior office action.

**Regarding claim 42:**

*Morita* teaches,

- input means for inputting a user's necessity or a user's non-necessity for each of pieces of information data (Abstract, "A document retrieval ... as a retrieval result"; Fig. 1; column 2, lines 39-43, "The input analysis ... by a user"; column 3, lines 7-9, "The user determines ... to the user")
- calculating means for calculating a prediction value predicting a user's necessity degree for each of a plurality of keywords attached to the pieces of information data according to the user's necessities and the user's non-necessities inputted to the input means for the pieces of information data and the keywords attached to the pieces of information data (Fig. 1; column 2, lines 43-65, "The input analysis ... the output controller 3"; column 3, lines 1-16, "The relevance values ... with predetermined equations"; column 4, lines 10-36, "The input portion 8 ... the retrieval result")
- assigning means for assigning expected and relevance values to each document (Fig. 1; column 2, lines 58-65, "The associative retrieval ... the output controller 3"; column 5, lines 20-22, "it is possible ... to the document")
- assigning means for assigning weight data to each keyword (Fig. 1; column 2, lines 43-46, "The input analysis ... associative retrieval unit 2"; column 4, lines 10-14, "The weight data ... the input layer 5"; column 5, lines 6-7, "Thus, in th ... of each keyword")

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However, *Morita* doesn't explicitly teach assigning means for assigning each prediction value calculated by the calculating means to the corresponding keyword while *Duke-Moran et al* teaches,

- assigning means for assigning each prediction value calculated by the calculating means to the corresponding keyword (Figs. 1-2, 9; column 15, lines 25-35, "The tags essentially indicate ... the word is TRUE")

Motivation – The portions of the claimed apparatus would have been a highly desirable feature in this art for

- Correlating electronically obtained media/text information (*Duke-Moran et al*, column 2, line 38, "correlating electronically obtained media/text information")

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify *Morita* as taught by *Duke-Moran et al* for the purpose of correlating electronically obtained media/text information.

**Regarding claim 43-50:**

Claims 43-50 are rejected for being dependent on the above rejected independent claim 42 and for reasons given in the prior office action.

**RESPONSE TO APPLICANTS' AMENDMENT REMARKS**

Applicant(s) argue(s) that each and every issue raised in the prior Office Action has been addressed and overcome (Amendment REMARKS page 15, paragraph 1).



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Applicant's 35 USC 102 arguments with respect to claim 33 have been considered but are moot in view of the new ground(s) of rejection given above.

***Priority***

Applicant(s) argue(s) that there is no need to resubmit certified copies of the priority applications in this application since they were submitted in the parent application serial number 08/707,565 (Amendment REMARKS page 11, paragraph 4).

The Examiner agrees and withdraws the objection.

***Information Disclosure Statement***

Applicant(s) argue(s) that the Kawai et al article and JP 06 243173 dates of publication are included in their citations on the IDS of 12/31/03 (Amendment REMARKS page 11, paragraph 5).

The Examiner recognizes the Kawai et al article's date of publication on the 12/31/03 IDS in an unexpected format: 1994, 5, 27. Applicants should also be informed that copies of references 2, 4 and 5 on the 4/29/04 IDS have yet to be located.

***Drawings***

Applicant(s) argue(s) that no new matter is introduced in the amendment to Figure 2 including the information recording medium and its outputs in view of

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the objections raised by the Examiner (Amendment REMARKS page 11, paragraph 2).

The amendment to Fig. 2 has been entered and examined. The objection to the drawing in the prior Office Action is withdrawn.

### ***Specification***

Applicant(s) argue(s) that the specification has been checked and changes made as requested by the Examiner (Amendment REMARKS page 11, paragraph 3).

The amendments to the specification (paragraphs beginning on page 6, line 15, page 9, line 12, page 18, line 19, page 31, line 17, page 39, line 12, page 50, line 8, page 56, line 22 and page 59, line 17) have been entered and examined. However, it is noted that "attached each" on page 14, line 5 would read well as "attached to each".

### ***Claim Rejections - 35 USC § 101***

Applicant(s) argue(s) that the amendment to claim 33 overcomes the rejection under 35 USC 101 since claim 33 defines the use of a computer and that new independent claim 42 is similarly directed to statutory subject matter (Amendment REMARKS page 12, paragraph 3).

The Examiner agrees claims 33 and 42 are directed to statutory subject matter and withdraws the earlier rejection.

***Obviousness-Type Double Patenting***

Applicant(s) argue(s) that the concept detailed in the instant application is not an obvious variant from that which is claimed in USPN 6,647,378 (Amendment REMARKS page 12, paragraphs 4-5 and page 13, paragraph 1).

The Examiner agrees that claims 33 and 42 of the instant application are not an obvious variant from USPN 6,647,378 claims 1 and 7. The obviousness-type double patenting rejection is withdrawn.

***Claim Rejections - 35 USC § 112***

Applicant(s) argue(s) that the invention now claimed is enabled by the specification (Amendment REMARKS page 13, paragraph 2).

The Examiner agrees claim 33 is enabled by the specification and withdraws the rejection.

***Claim Rejections - 35 USC § 102 and 35 USC § 103***

Applicant(s) argue(s) that Morita USPN 5,297,042 does not teach each and every limitation of claim 33 as required under 35 USC 102: a method wherein a user's necessity or a user's non-necessity for each piece of information is inputted, and then a prediction value is calculated according to the inputted user's necessity or the user's non-necessity (Amendment REMARKS page 14, paragraph 1).

Applicant's 35 USC 102 arguments with respect to claim 33 have been considered but are moot in view of the new ground(s) of rejection given above.

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The Examiner considers applicant's each piece of information inputted and prediction values calculated according to the inputted user's necessity or the user's non-necessity as inherent and/or obvious variants of Morita's teachings covering inputting and calculating on a plurality of keywords, weight data, retrieval/relevance values, expected values, relationship values and importance values (Abstract, column 2, lines 39-43, column 2, lines 43-65, column 3, lines 1-16, column 4, lines 10-36, column 5, lines 6-7, column 5, lines 20-22).

Specifically, the calculation of a relevance value for each document (i.e. 'each piece of information' taught in column 2, lines 58-65) and application of an expected value to a document (column 5, lines 20-22) suggests the prediction value (relevance or retrieval value in Morita) applies to all keywords in a piece of information (document). Because the claims have been modified from assigning the prediction value to each of the keywords to assigning each calculated prediction value to the corresponding keyword, Duke-Moran et al column 15, lines 25-35 is cited for disclosing subject matter of this limitation set forth in the amended claims. Further, column 2, line 38 of Duke-Moran et al provides correlating electronically obtained media/text information as the motivation for and purpose in combining the references.

As set forth above with regards to Morita and Duke-Moran et al, the citations explicitly and inherently teach each element of the applicants' claimed limitations. Applicants have not set forth any distinction or offered any dispute between the claims of the subject application, Morita's Keyword associative document

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retrieval system and Duke-Moran et al's Searching media and text information and categorizing the same employing expert system apparatus and methods.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- *Duke-Moran et al*; USPN 5,819,259; Searching media and text information and categorizing the same employing expert system apparatus and methods

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Any inquiry concerning this communication or earlier communications from the Office should be directed to Melvin Bell whose telephone number is 703-305-0362. This Examiner can normally be reached on Mon - Fri 7:30 am - 4:30 pm.

If attempts to reach this Examiner by telephone are unsuccessful, his supervisor, Anthony Knight, can be reached on 703-308-3179. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MB / *M. B.*

*Ramesh Patel*  
RAMESH PATEL  
PRIMARY EXAMINER 8/6/04  
*For Anthony Knight*